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Dated: 11-21-08

By Barbara Barrera
Barbara Barrera

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re:

Application Serial No. 77/006,212

Applicant: Kirby, James T.

Date Filed: September 29, 2006

Mark: COCAINE

NOTICE OF APPEAL TO UNITED
STATES COURT OF APPEAL FOR
THE FEDERAL CIRCUIT

Applicant, pursuant to Trademark Rule 2.145 (37 C.F.R. §2.145), hereby appeals to the United States Court of Appeal for the Federal Circuit from the final decision dated September 22, 2008 of the Trademark Trial and Appeal Board affirming the Examining Attorney's refusal of registration.

Dated: 11/21/08

Respectfully submitted,

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22 September 2008
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re James T. Kirby

Serial No. 77006212

Clegg Ivey, Esq. for James T. Kirby.

Michael Engel, Trademark Examining Attorney, Law Office 107
(J. Leslie Bishop, Managing Attorney).

Before Quinn, Rogers, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 25, 2006, applicant James T. Kirby filed
an application to register on the Principal Register the
mark COCAINE and design shown below:



Cocaine

For "carbonated and non-carbonated soft drinks and energy
drinks" in class 32. The date of first use anywhere is

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listed as March 3, 2006, and the date of first use in commerce is listed as June 30, 2006. Serial No. 77006212.

The examining attorney has refused to register the mark on the ground that the mark is "immoral or scandalous within the meaning of Trademark Act Section 2(a)." 15 U.S.C. 1052(a). Brief at 1. The examining attorney argues that "Cocaine is an illegal drug, with harsh penalties for its possession or use. Its use as a product name for energy drinks has been widely condemned." Brief at unnumbered p. 2. When the examining attorney made the refusal final,¹ applicant filed this appeal.

Evidence

The examining attorney has submitted three internet articles that all refer to an energy drink called "Cocaine." Highlights from the articles² are set out below:

I. www.cbsnews.com (May 7, 2007)

"Cocaine" Pulled from Shelves Nationwide
An energy drink called Cocaine has been pulled from stores nationwide amid concerns about its name, the company that produces it said Monday.

Clegg Ivey, a partner in Redux Beverages LLC of Las Vegas, said the company plans to sell the drink under a new name for now.

¹ In his Final Office Action, the examining attorney withdrew refusal under Section 2(e)(1) of the Trademark on the grounds that the mark was descriptive or deceptively misdescriptive.

² Applicant admits that at least the first two articles refer "to Applicant's marketing campaign." Brief at unnumbered p. 2.

The Food and Drug Administration issued a warning letter this month that said Redux was illegally marketing the drink as a street drug alternative and a dietary supplement. May 4 was the deadline for the company to respond.

The FDA cited as evidence the drink's labeling and Web site, which included the statements "Speed in A Can," "Liquid Cocaine" and "Cocaine - Instant Rush." The company says Cocaine contains no drugs and is marketed as an energy drink. It has been sold since August in at least a dozen states...

Ivey said the FDA did not order the company to stop marketing the drink, but officials were concerned about possible legal action. They will announce a new name within a week and hope to have the product back on store shelves within a few weeks.

"What we would like to do is continue to keep the name because it's clearly the name that's the problem," Ivey said, "what we can't do is distribute our product when regulators in the states and the FDA are saying that if you do this, you could go to jail."

Attorneys general in Connecticut and Illinois recently announced that Redux had agreed to stop marketing Cocaine in those states, while a judge in Texas has halted distribution there.

"Our goal is to literally flush Cocaine down the drain across the nation," said Connecticut Attorney General Richard Blumenthal, who announced the company's agreement with his state Monday. "Our main complaint about Cocaine is its name and marketing strategy seeking to glorify illegal drug use and exploit the allure of marketing "Speed in a Can," as it called the product."

II. www.nytimes.com (October 2, 2006)

Politicians Say Soft Drink Glamorizes Drugs

Outraged New York City lawmakers denounced today the manufacturer of a new, highly caffeinated soft drink called Cocaine and called for a boycott of the beverage, saying it glamorized an illegal and deadly narcotic that has ravaged urban neighborhoods since the epidemic of the 1980's.

"There are only two reasons that you would seek to use this infamous and insidious name to market your so-called energy drink," said Councilman James Sanders, Jr. of Queens, who organized a news conference at City Hall. "Either you are woefully ignorant of the horrors of cocaine addiction, or your god is the dollar bill and not even human life is more sacred."

The beverage has attracted considerable publicity, most of it negative, since its introduction in Southern California. The company's web site lists five retailers that sell the beverage - all of them in or around New York City. It is also available in Los Angeles and San Diego.

While the Web site states that "we don't advocate drug use," it suggests that the carbonated beverage should be mixed with alcohol - offering recipes for cocktails with names like Liquid Cocaine, Cocaine Smash, Cocaine Blast and Cocaine Snort. The site touts the beverage's page on MySpace, a heavily trafficked social-networking site that is popular among children and teenagers.

Experts in drug use and nutrition condemned the beverage.

Joseph A. Califano Jr., chairman and president of the National Center on Addiction and Substance Abuse at Columbia University, used five adjectives - insidious, disgraceful, irresponsible, reprehensible and disgusting - to describe the soft drink.

In a statement, Mr. Califano, who was secretary of health, education and welfare in the Carter administration, said it was "clearly aimed at children and teen 'partygoers.'"

III. www.energyfiend.com

Cocaine Energy Drink Banned in Australia

The energy drink called cocaine will not be going on sale in Australia who are refusing to import it. Apart from the most unfortunate name of the drink, Australia has restrictions on caffeine levels in drinks - currently 145 mg. per liter (33.8 fl. oz.)

In the US, Cocaine is getting its fair share of controversy with many stores refusing to stock it. There have been protests in some communities with protestors claiming the drink glorifies drug abuse.³

Applicant has submitted no evidence to support its position that the mark is not immoral or scandalous. However, applicant does argue that "the US Patent and Trademark Office has allowed registration of (or published for opposition) a variety of drug-related marks for use in conjunction with energy drinks, including EXTAZY, BLACK OPIUM, METH, BONG WATER, DIESEL, JUICE and KRONIK. All of these marks are named after illicit drugs or, in the case of BONG WATER, illicit paraphernalia." Response dated September 25, 2006 at 3.

We point out that the "Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record." *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998). However, if "the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise applicant that a listing is insufficient

³ This article is relevant because of its discussion of the goods and the reaction to the mark COCAINE on beverages in the United States.

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to make such registrations of record at a point when the applicant could cure the insufficiency, the examining attorney will be deemed to have waived any objection as to improper form." TBMP § 1207.03 (2d ed. rev. 2004). In this case, the examining attorney has not advised applicant that simply listing the marks was not enough to make them of record. While we therefore can consider these references, the limited information here is entitled to little weight. TBMP § 1208.02 ("The Board will not consider more than the information provided by applicant. Thus, if applicant has provided only a list of registration numbers and marks, the list will have very limited probative value").

We add that the reference to a list of terms that may or may not be registered is not very persuasive. Most of the terms or their phonetic equivalent to which applicant refers have more than one meaning such as EXTAZY, DIESEL, JUICE and KRONIK. If a term has more than one meaning, it may indicate that the term is not scandalous. In re *Boulevard Entertainment Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1478 (Fed. Cir. 2003). Also, to the extent that applicant has admitted that some of these marks are for pending applications, we point out that "such material is incompetent as proof of anything other than the fact that

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such an application for registration was filed in the Patent Office." *Zappia-Paradiso, S.A. v. Cojeva Inc.*, 144 USPQ 101, 102 n.4 (TTAB 1964). See also *Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 62, 65 n.5 (TTAB 1981)

("Introduction of the record of a pending application is competent to prove only the filing thereof") and *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1050 n.4 (TTAB 2002) ("While applicant also submitted a copy of a third-party application ... such has no probative value other than as evidence that the application was filed"). This is true also for a mark that may be immoral and scandalous and subject to opposition in the Office on that basis. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) and *Bromberg v. Carmel Self Service, Inc.*, 198 USPQ 176 (TTAB 1978).

We add that even if applicant did make copies of the registration of other marks properly of record, it would not dictate the result in this case. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court"). *Accord Jaquet-Girard S.A. v. Girard Perregaux & Cie., S.A.*, 423 F.2d 1395, 165 USPQ 265, 266 (CCPA 1970)

("Appellant relies primarily on four prior rulings in this court on other marks but, as we have often said, prior decisions on different marks used under different circumstances are of little value"). Therefore, even to the extent that we can consider applicant's references to other terms, we find that it is entitled to little weight.

Applicant also refers to subsequent dealings with the FDA in his brief. The examining attorney has not had an opportunity to respond to these arguments with evidence. However, these references are simply argument of counsel and they are a poor substitute for evidence. The CCPA has noted in a case regarding arguments of counsel, a party "had ample opportunity to submit rebuttal evidence but failed to do so, placing his faith in the arguments of counsel, which are not evidence." *Peeler v. Miller*, 535 F.2d 647, 190 USPQ 117, 121 (CCPA 1976). See also *Enzo Biochem Inc. v. Gen Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) ("Attorney argument is no substitute for evidence"). Similarly, counsel's arguments in his appeal brief are not evidence and we will not rely on them.

Applicant also refers to several lists that are apparently available at Wikipedia.org concerning drug references in songs and movies. This evidence is obviously

untimely and we will not consider it. 37 CFR § 2.142(d).

In re Trans Continental Records Inc., 62 USPQ2d 1541, 1541

n.2 (TTAB 2002) (Exhibits from web search engines not

considered when submitted for the first time on appeal).

We also point out that a "mere reference to a website does

not make the information of record." *In re Planalytics*

Inc., 70 USPQ2d 1453, 1457 (TTAB 2004).

With these evidentiary clarifications, we now address the merits of the appeal.

Section 2(a) Refusal

Applicant seeks to register the mark COCAINE and design for carbonated and non-carbonated soft drinks and energy drinks. Cocaine is defined as: "A bitter, crystalline alkaloid, obtained from coca leaves, used as a local anesthetic and also widely used as an illegal drug for its stimulant and euphorogenic properties" (chemical formula omitted).⁴ Cocaine is a controlled Schedule II substance:

2) Schedule II.--

(A) The drug or other substance has a high potential for abuse.

(B) The drug or other substance has a currently accepted medical use in treatment in the United States

⁴ *The Random House Dictionary of the English Language* (unabridged) (2d ed. 1987). We take judicial notice of this and the other definitions included in this opinion. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

or a currently accepted medical use with severe restrictions.

(C) Abuse of the drug or other substances may lead to severe psychological or physical dependence.

21 U.S.C. § 812.

The question here is whether the use of the term COCAINE on soft drinks and energy drinks is scandalous. In order to demonstrate that a mark is scandalous, the Federal Circuit has set out that:

the PTO must demonstrate that the mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; ... giving offense to the conscience or moral feelings; ... [or] calling out [for] condemnation." *In re Riverbank Canning Co.*, 95 F.2d 327, 328, 37 USPQ 268, 269 (CCPA 1938) (citations omitted). The PTO must consider the mark in the context of the marketplace as applied to only the goods described in [the] application for registration. *In re McGinley*, 660 F.2d 481, 485, 211 USPQ 668, 673 (CCPA 1981). Furthermore, whether the mark..., including innuendo, comprises scandalous matter is to be ascertained (1) from "the standpoint of not necessarily a majority, but a substantial composite of the general public," *id.*, 211 USPQ at 673, and (2) "in the context of contemporary attitudes," *In re Old Glory Condom Corp.*, 26 USPQ2d 1216, 1219 (TTAB 1993).

In re Mavety Media Group Ltd., 33 F.3d 1367, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994). See also *Boulevard Entertainment*, 67 USPQ2d at 1477 ("To justify refusing to register a trademark under the first clause of section 1052(a), the PTO must show that the mark consists of or comprises 'immoral, deceptive, or scandalous matter.' A showing that a mark is vulgar is sufficient to establish

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that it 'consists of or comprises immoral ... or scandalous matter' within the meaning of section 1052(a)" (citation omitted).

As *Mavety* requires, we must look at the mark in the context of the goods. In this case, the goods are relatively inexpensive soft drinks and energy drinks. There are two features of applicant's goods that are particularly relevant. First, the potential purchasers of these goods would encompass virtually all consumers, including adults, teenagers, and children old enough to make their own purchasing decisions. Applicant's marketing practices include a website that "touts the beverage's page on MySpace, a heavily trafficked social networking site that is popular among children and teenagers."

www.nytimes.com. Second, the goods are beverages, which are eatable or consumable. The word "Cocaine" is not objectionable because it is vulgar, as were the offensive words that have been refused registration in *Boulevard Entertainment* and *In re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006), inasmuch as it is a term that would be commonly used to refer to the drug. However, when used in combination with soft drinks and energy drinks, the term does not have a neutral meaning, as it might when used in a news story or medical reference. Applicant's identification of goods

includes soft drinks and energy drinks that are highly caffeinated. Indeed, applicant's goods are described that way. See www.nytimes.com. Caffeine is defined as "a white, crystalline bitter alkaloid usually derived from coffee or tea: used in medicine chiefly as a nervous system stimulant." (chemical formula omitted).⁵ While we are aware that cocaine and caffeine are significantly different both legally and chemically, nonetheless they both are a type of stimulant.

The evidence shows that applicant's website "suggests that the carbonated beverage should be mixed with alcohol - offering recipes for cocktails with names like Liquid Cocaine, Cocaine Smash, Cocaine Blast and Cocaine Snort." www.nytimes.com. Applicant has promoted his product as "Speed⁶ in A Can," "Liquid Cocaine" and "Cocaine - Instant Rush." Because the product is an inexpensive "highly caffeinated soft drink" that can be purchased by teens and children and is advertised in a manner so as to suggest an illegal drug-like effect, it has a scandalous meaning when used in association with these goods.

⁵ *The Random House Dictionary of the English Language* (unabridged) (2d ed. 1987).

⁶ "Speed" is slang for "methamphetamine." *Webster's II New Riverside University Dictionary* (1984).

The board arrived at the opposite conclusion when it considered the mark ACAPULCO GOLD for suntan lotion. In that case the board held:

While the notation "ACAPULCO GOLD" may be a synonym for marijuana, the question as to whether or not a term is scandalous or immoral within the meaning of Section 2(a) of the Statute must necessarily be considered in relationship to the goods in connection with which it is used. The goods in this case [are] suntan lotion, and, in our opinion, to the average purchaser of suntan lotion in the normal marketing milieu for such goods, the term "ACAPULCO GOLD" would suggest the resort city of Acapulco noted for its sunshine and other climatic attributes rather than marijuana. Under such circumstances, "ACAPULCO GOLD" does not fall within the prohibition of Section 2(a).

In re Hepperle, 175 USPQ 512, 512 (TTAB 1972).

There are two significant differences between these cases. First, the term "cocaine" has no other meaning besides the name of the drug. Second, the *Hepperle* goods, suntan lotion, were not associated with the use of marijuana. Applicant's highly caffeinated soft drinks are marketed as "Liquid Cocaine" and "Speed in a Can" and applicant promotes its use with alcohol in drinks called Cocaine Smash, Cocaine Blast and Cocaine Snort. As the evidence indicates, it is not surprising that a product that can be bought by adults, teens, and children, that associates itself with a drug that is illegally used, and that is promoted to be combined with alcohol has met with controversy. The association of applicant's product with a

drug that is widely abused is significant. Both applicant's product and COCAINE are stimulants. By suggesting through the use of the mark COCAINE that its product can, to some degree, approximate the stimulant effect of the drug, applicant's mark is used in a way that supports the conclusion that the term COCAINE comprises scandalous matter as ascertained from a substantial composite of the general public in the context of contemporary attitudes. We add that we have also considered the fact that applicant has sought registration of the term COCAINE in white letters in a red square. However, this additional design feature does not change the impact of the word COCAINE when used on the identified goods.

We also have taken into consideration applicant's statement that applicant has "revamp[ed] its advertising campaign." Brief at unnumbered pp. 3-4. As we indicated earlier, we have no evidence on this point. We also point out that applicant admits that he "used terms like 'speed in a can' and 'liquid speed.'" Brief at 3. Furthermore, regardless of the current state of applicant's advertising, we have no evidence to conclude that applicant is prohibited from resuming marketing strategies that associate his goods with illegal drug use. *Accord Russell*

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Chemical Co. v. Wyandotte Chemicals Corp., 337 F.2d 660, 143 USPQ 252, 253 (CCPA 1964) ("Since the marketing environment is subject to change at any time it should not form the basis for any conclusive inference with respect to the issue of likelihood of confusion") and *Meyer Chemical Co. v. Anahist Co.*, 263 F.2d 344, 120 USPQ 483, 484 (CCPA 1959):

The nature of goods specified in the application is not limited by specimen labels. Such labels are subject to change without notice to the Patent Office. Either a change in the composition of the product or in prescription standards could, moreover, free "Almehist" for over the counter sales while its description would still be a "Preparation for Relief of Allergic Conditions in Capsule Form." We hold that under these circumstances the present differences in marketing methods do not form a proper basis for finding lack of likelihood of confusion or mistake when the respective trademarks are used on the goods enumerated.

Applicant has also argued that the "examining attorney failed to consider the mark in the context of the marketplace for energy drinks." Brief at 4. Applicant's argument is undercut by his own failure to submit any evidence on the marketplace other than his counsel's statement. Furthermore, the evidence of the examining attorney supports the conclusion that the marketplace for energy drinks is not as tolerant of clearly drug-related terms as applicant suggests.

Applicant also faults the examining attorney for "failing to demonstrate that a substantial composite of the general public would find the mark scandalous." We point out that for certain highly offensive terms, a dictionary definition only may be sufficient to demonstrate that a substantial composite of the public would find the mark scandalous. *Boulevard Entertainment*, 67 USPQ2d at 1478 ("In this case, we answer the question left open in *Mavety* by holding that, in a case in which the evidence shows that the mark has only one pertinent meaning, dictionary evidence alone can be sufficient to satisfy the PTO's burden"). "Cocaine" is not such a term that a simple definition is enough to establish that it is scandalous to a substantial composite of the general public. But in this case, we have evidence that the FDA, Connecticut and Illinois Attorneys General, and New York City Council members all protested the use of the mark COCAINE with soft drinks. A former Secretary of Health, Education and Welfare described the use of the mark on applicant's goods as: "insidious, disgraceful, irresponsible, reprehensible and disgusting." Another site refers to: "protests in some communities." We note that this evidence is not general speculation but evidence that applicant's mark as used on his goods has generated the controversy that a

scandalous mark would. We conclude that the evidence supports the examining attorney's conclusion that applicant's mark is scandalous to a substantial composite of the general public in the context of contemporary attitudes.

We also address applicant's argument that there has been "a major shift in social attitudes, with a clear trend toward acceptance of drug references as apart of mainstream culture." Brief at 7. We point out again that applicant has submitted no admissible evidence to support this argument. The examining attorney's evidence suggests that, even if there was some evidence to support his argument, this alleged "shift in social attitudes" is not as great as applicant asserts. Finally, we add that we are looking at applicant's mark in the context of applicant's goods, which include highly caffeinated energy drinks. The potential purchasers of these goods include teens and children. There is no suggestion in applicant's argument that there has been a societal shift in its values away from protecting children and teens from the promotion of illegal drugs. We also cannot accept applicant's suggestion that his use is "tongue-in-check" (Brief at 8). Again, coming back to applicant's goods and advertising, he is selling a highly caffeinated beverage (a stimulant) that he has

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promoted its use in combination with alcohol. Applicant has chosen to describe the goods by such terms as "Speed in A Can." The public is unlikely to recognize this as tongue-in-check use.

Inasmuch as we have no doubts that applicant's mark COCAINE and design for the identified goods is scandalous, we affirm the examining attorney's refusal.

DECISION: The examining attorney's refusal under Section 2(a) of the Trademark Act is affirmed.